

REMARKS

Claims 18, 22, 27 and 37 are canceled in this response.

New claims 45-47 are added. Support for the new claims is provided by exemplary embodiments of the invention disclosed at, for example, page 8 of the originally-filed application.

Claims 16-22, 24-39, 42 and 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morland et al (US 4,759,154), in view of Allen et al (US 2,879,632). Claims 40 and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morland et al in view of Allen et al as applied to claims 16 and 36, and further in view of Paris, Jr. et al (US 5,919,563). Claim 41 is rejected under 35 U.S.C. §103(a) as being unpatentable over Morland et al in view of Allen et al as applied to claims 16 and 36, and further in view of Lipman (US 5,451,281).

Independent claim 16 is rejected over the combination of Morland and Allen. Independent claim 16 is amended to recite "after the aligning of the spectacle lens relative the second holder, **providing connecting material to the second holder.**" Support for the amendment language is provided by, for example, exemplary embodiments of the invention disclosed at page 8 and figure 6 of the originally-filed application.

Of the combination of art, the office relies upon Morland to allegedly teach the amendment language. However, Morland teaches providing adhesive to the second holder 2 (col. 3, Ins. 20-21) **before** aligning the lens relative the second holder 2 (col. 3, Ins. 10-20), **not after** as positively

recited by independent claim 16. That is, Morland teaches to first apply adhesive to the "rounded surface" of the second holder 2 (col. 3, Ins. 18-21). Second, Morland teaches to move second holder 2 on carriage 1 "down on its slide until the rounded surface of the [second holder] 2 touches the base curve 16 of the partly cut [lens] blank [15]" (col. 3, Ins. 16-18). Third, Morland teaches with the rounded surface of the second holder 2 in base curve 16 (and correspondingly in machined surface 17), the lens blank 15 adjusts and centralizes its position relative to the [second holder] 2" (col. 3, Ins. 31-34). Accordingly, Morland teaches providing adhesive to the second holder 2 before aligning the lens blank 15 relative the second holder 2. Logically, the art of record, singularly or in any combination, fails to teach or suggest "after the aligning of the spectacle lens relative the second holder, providing connecting material to the second holder" as positively recited by independent claim 16. Since the art of record fails to teach or suggest a positively recited limitation of independent claim 16, independent claim 16 is allowable.

Claims 17-20, 29-30, 38-41 and 45-47 depend from allowable independent claim 16, and therefore, the dependent claims are at least allowable for depending from an allowable independent claim. In addition, the dependent claims are allowable for reasons that are distinct to the allowability of claim 16.

Independent claim 21 is amended by the limitations of dependent claim 22 and now positively recites, "wherein said alignment reference

comprises a **transverse web** extending generally perpendicularly to an optical axis of the spectacle lenses." The combination of art fails to teach or suggest a "transverse web." In fact, respectfully, the Office fails to address the limitation directed to a **transverse web** in the pending action. The Office is reminded, respectfully, that the most recently updated MPEP still includes the section entitled, *All Claim Limitations Must Be Considered* (MPEP §2143.03) which states: "All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." Since the Office has failed to demonstrate a teaching in the prior art to a positively recited limitation of independent claim 21, a *prima facie* case of obviousness against independent claim 21 has not been established. Independent claim 21 is allowable.

Claims 24-25, 31-32 and 42 depend from allowable independent claim 21, and therefore, the dependent claims are at least allowable for depending from an allowable independent claim. In addition, the dependent claims are allowable for reasons that are distinct to the allowability of claim 21.

For example, dependent claim 42 recites "wherein the markings comprise only two lines intersecting." Of the combination of art, the Office relies on Allen to teach this limitation. However, Allen teaches no less than 20 (twenty) graduated lines as markings. Accordingly, it is inconceivable

that the combination of art teaches "the markings comprise only two lines" as positively recited by claim 42. For this reason alone, claim 42 is allowable for reciting a limitation not taught by the combination of art. Moreover, being graduated lines, Allen does not teach "intersecting" lines as positively recited by claim 42. For this additional reason alone, claim 42 is allowable.

Independent claim 26 is amended by the limitations of dependent claim 27 and now positively recites, "wherein said alignment reference structure comprises a **transverse web** extending generally perpendicularly to an optical axis of the spectacle lenses." The combination of art fails to teach or suggest a "transverse web." As stated previously, the Office fails to address the limitation directed to a **transverse web** in the pending action. Since the Office has failed to demonstrate a teaching to all the limitations recited by independent claim 26, a *prima facie* case of obviousness against independent claim 26 has not been established. Independent claim 26 is allowable.

Claims 28, 33-35 and 43 depend from allowable independent claim 26, and therefore, the dependent claims are at least allowable for depending from an allowable independent claim. In addition, the dependent claims are allowable for reasons that are distinct to the allowability of claim 26.

For example, dependent claim 43 recites "wherein the markings comprise two lines intersecting at right angles." Of the combination of art, the Office relies on Allen to teach this limitation. However, Allen teaches no

less than 20 (twenty) graduated lines as markings, not intersecting and not at right angles. Accordingly, it is inconceivable that the combination of art teaches "the markings comprise **two lines intersecting at right angles**" as positively recited by claim 43. Claim 43 is allowable for reciting limitations not taught by the combination of art.

Independent claim 36 is amended by the limitations of dependent claim 37 and now positively recites, "releasing the spectacle lens from the collet chuck by applying pressure to the collet chuck along an axis **parallel** to an optical axis of the spectacle lens." Of the combination of art, the Office relies on Allen to teach this limitation (para. 9 of pg. 5 of paper no. 20090227). However, Allen teaches a handle 82 is rotated **about** an optical axis (not parallel to the axis) of lens blank 120 to allow expansion of collet jaws for releasing lens blank 120 (col. 4, Ins. 36-49 and col. 5, Ins. 52-58). Consequently, Allen teaches pressure is applied **about** the collet chuck and **about** an axis parallel to the optical axis, and not "**parallel** to an optical axis" as positively recited by independent claim 36. Therefore, the art of record, singularly or in any combination, fails to teach or suggest "releasing the spectacle lens from the collet chuck by applying pressure to the collet chuck along an axis **parallel** to an optical axis of the spectacle lens" as positively recited by claim 36. Claim 36 is allowable.


Claim 44 depends from allowable independent claim 36, and therefore, the dependent claim is at least allowable for depending from an allowable

independent claim. In addition, the dependent claim is allowable for reasons that are distinct to the allowability of claim 36.

This application is now believed to be in immediate condition for allowance and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: 6-23-09

By: 
D. Brent Kenady
Reg. No. 40,045